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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>March 4, 2009</u></p> <p>Signature <u><i>Elaine F. Mian</i></u></p> <p>Typed or printed name <u>Elaine F. Mian</u></p>		Application Number	Filed
		10/761,849	1/20/2004
		First Named Inventor	
		Kuldeep Jain	
		Art Unit	Examiner
		2451	Patel, Dhairya A.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>60,470</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p><u><i>John A. Garrity</i></u> Signature John A. Garrity Typed or printed name</p> <p><u>(203) 925-9400</u> Telephone number</p> <p><u>March 4, 2009</u> Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE U.S. PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

APPLICANTS: Kuldeep Jain et al.

SERIAL NO.: 10/761,849

FILING DATE: January 20, 2004

EXAMINER: Patel, Dhairya A

ART UNIT: 2451

ATTORNEY'S DOCKET NO.: 871.0119.U1 (US)

TITLE: METHOD AND APPARATUS TO TERMINATE DIAL-UP
CONNECTIONS ON MOBILE DEVICES

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Request for Review

Sir:

This is in response to the final Office Action dated November 24, 2008, for the above-referenced US Patent Application, and is filed with the Applicant's Notice of Appeal.

A current listing of claims for the Application may be seen in the Applicant's Amendment dated January 16, 2009. Claims 1, 13, and 25 are independent, and for purposes of this Pre-Appeal Conference only, the arguments presented herein are primarily directed to these three independent claims. The Applicants note that independent claims 1, 13, and 25 are rejected under 35 USC 103(a) as unpatentable over Dorenbosch (US6,768,726), in view of Phillips (US6,370,399).

Firstly, the Applicants note that the Examiner appears to have changed the basis of rejection between the final Office Action dated November 24, 2009 and the Advisory Action dated February 19, 2009. In the final Office Action the rejection alleged that element 209 in Figure 2 of Dorenbosch was suggesting the computing device of claim 1. However, as indicated in the Advisory Action it can be seen that the Examiner is now alleging that the gateway in Dorenbosch (e.g. gateway 205) is suggesting the computing device of claim 1. The Applicants submit that none of these rejections are proper for at least the reason that the references cited can not be seen

to disclose or suggest claim 1.

Claim 1 recites:

A method, comprising: initiating a set up of an internet protocol (IP) connection between a mobile station (MS) and a computing device (CD), the IP connection being one that terminates at the MS, the initiation of the set up of the IP connection **comprising receiving a command from the CD over a local interface between the MS and the CD**; establishing the IP connection between the MS and the CD **comprising the MS assigning an IP address to the CD and an IP address to the MS**, and configuring an IP protocol stack at the MS; and in response to receiving over the IP connection an IP message at the MS from the CD, routing the received IP message to an application that is resident in the MS

In the Advisory Action the Examiner states "In column 5 lines 44-55, Dorenbosch teaches assigning first IP address to the gateway by informing the gateway by the first station (i.e. assigning IP address to the CD)." The Applicants note that, as cited, Dorenbosch merely discloses that the first station 203, having a connection to a cellular system, performs an initiation and set-up of an IP connection by **informing an Internet gateway 205, through the cellular network, of its IP address (A1)** (col. 5, lines 43-46). The Applicants submit that there is nothing in Dorenbosch which can be seen to support that the first station 203 is **assigning an IP address** to the gateway 205.

Dorenbosch discloses that "The mobile station B **must also get the first IP address, IP A1** to be used by the gateway," and "preferably the mobile station **obtains a private IP address, IP A1** that is local to the cellular system," (emphasis added), (col. 6, lines 23-28). In addition, the Applicants note that Dorenbosch discloses that **alternatively the mobile station (203) can get its address A1 from the gateway 205 and the gateway also assigns the external address Y1**, and it may even be that the mobile station will not be aware of the external address (see col. 6, lines 37-40).

The Applicants submit that language, as stated above in Dorenbosch, with relates to the mobile station 203 **getting or obtaining** the A1 address, supports a conclusion that **the gateway, not the mobile station, is assigning the A1 address** to the mobile station as well as assigning the

external Y1 address for the end-point 209. Moreover, regarding the “alternatively” language, the Applicants can find only where Dorenbosch appears to disclose another alternative being that the mobile station already has the A1 IP address (for example col. 3; lines 30-35). The Applicants submit that, in all of Dorenbosch, there can not be found any disclosure related to the mobile station 203 assigning an IP address to the end-point 209, or the gateway 205, as is argued by the Examiner in the final Office Action and the Advisory Action, respectively.

The Applicants contend that, for at least the reasons already stated, Dorenbosch can not be seen to disclose or suggest, as indicated in the rejection, at least where claim 1 relates to establishing the IP connection between the MS and the CD comprising **the MS assigning an IP address to the CD and an IP address to the MS**. The Applicants submit that, for at least these reasons, it can be seen that the rejection of claim 1 is improper and the rejection should be removed.

Further, the Applicants note that the Examiner admits:

“Dorenbosch does teach initiation of the set up of the IP connection comprising receiving a command over a local interface between MS and CD but is silent in teaching command from the CD over a local interface between MS and the CD. Dorenbosch is also silent in teaching in response to receiving over the IP connection an IP message at the MS from the CD, routing the received IP message to an application that is resident in the MS,” and

“It would have been obvious to one of ordinary skill in the art at the time of applicant’s invention was made to **implement Phillips’s teaching in Dorenbosch’s teaching to come up with having receiving command from the CD over the local interface and receiving IP message at MS and routing the message to an application**. The motivation for doing so would be to establish a TCP/IP connection based on the connect message signal, therefore data packet transfer from the mobile terminal to the TE device can take place with ease,” (emphasis added).

Although the Applicants do not agree that a combination of Dorenbosch and Phillips is even proper, the Applicants contend that one skilled in the art would clearly not be motivated to make such a combination.

The Applicants submit that, as argued in the prior Response to Office Action filed on 3 September 2008, the mobile station (CDMA cellular phone) of Phillips is seen to function as a "solid wire connection" to connect the computer to the internet. Dorenbosch, as stated above, discloses that the first station 203 is connected to a cellular system, and **informing an Internet gateway 205, through the cellular network, of its IP address (A1)** in order to perform packet data communication with the gateway 205 **through the cellular system**. The Applicants note that, here, the Examiner appears to impute **a local connection**, as in Phillips, **between the first station 203 and the gateway 205** (or end-point 209) of Dorenbosch. The Applicants submit that this is clearly not supported for at least the reason that Dorenbosch relates to a connection between a mobile station (i.e. first station 203) and a cellular network. The combination is clearly improper for at least the reason that a mobile user in Dorenbosch would not be motivated to create a local connection between a mobile device and a gateway in a cellular network, where the connection to the gateway is via a cellular tower of the cellular network that is within the range of the mobile device.

It is noted that in the previous Office Action the Examiner admitted that "Phillips is silent in teaching assigning IP addresses for local interface and configuring an IP protocol stack at the MS."

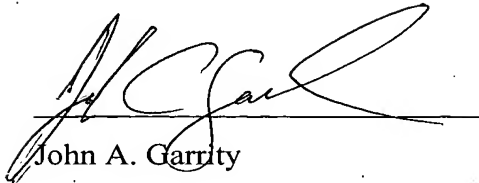
The Applicants submit that for at least the reasons stated, even if Dorenbosch were combined with Phillips, which is not agreed to as proper, the combination would still fail to disclose or suggest claim 1.

Further for at least the reasons that independent claims 13 and 25 relate to features similar to claim 1, as stated above, the references cited can not be seen too disclose or suggest these claims. Thus, the rejections of all claims 1, 13, and 25 should be removed.

In addition, for at least the reasons that claims 2-12, 14-24, and 26-40 depend from claims 1, 13, and 25, respectively, the rejections of these claims are seen to be improper and should be removed.

S.N.: 10/761,849
Art Unit: 2451

Respectfully submitted:



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3/4/2009
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